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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,915	08/31/2001	Hitoshi Ozawa	1614.1185	8125
21171	7590	06/27/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			HAN, QI	
			ART UNIT	PAPER NUMBER
			2654	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/942,915	Applicant(s) OZAWA ET AL.	
	Examiner Qi Han	Art Unit 2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

U.S.C. National Stage Application

1. Acknowledgement is made of the indication that the present application is filed under 35 U.S.C. 371, of the indication that the required form PCT/DO/ED/903 is present, and of the use of transmittal form PCT/DO/EO/1390. Thus, the present application is being treated as a filing under 35 U.S.C. 371.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification and drawings

3. The disclosure is objected to because of the following:
- a. On page 2, lines 24-26, by reviewing the context in the same paragraph, it is unclear what the applicant wants to conclude. Appropriate correction or explanation is required.
 - b. In Fig. 7, it is unclear that the terms “part” in step S8 and “portion” in step S9 indicate the same subject matter or not. If same, appropriate correction is required for consistently choosing one of the terms. If not same, a clear definition or description is required.

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- c. In Figs. 8-9, regarding the steps S35 and S37 of “Does word class of (the—in S37) differing portion of original match Jth portion of translated text?”:
- i) the step itself is confused and/or not descriptive, since it is unclear which “original” and “translated text” (there are two original data translated texts according to page 9, lines 13) is used for matching;
 - ii) it is also unclear what difference between two steps S35 and S37 (they are almost identical). Appropriate correction or explanation is required.
- d. On page 11, lines 7-12, this is related to objection b (see above). The context of “**translate** the Jth part of ...**to the language of the original text data** using commonly used dictionaries” is so confused that the examiner cannot figure out what the applicant is trying to say. The specification also fails to clearly describe what the relationship is between using the normal dictionary (402) and generating variable. Appropriate correction or explanation is required.
- e. Relating to Fig. 3 and Figs. 6-10, according the specification, Fig. 3 shows the principle structure (page 6, lines 22-29) and Figs. 6-10 show the process (page 11, lines 30-32), for the claimed invention. It appears that the both disclosed structure and process are for generating new translation-example dictionary, but a notable difference is that the process uses “normal dictionary” (Fig. 9) and the structure does not (Fig. 3), which is inconsistent between the structure and process disclosures. Appropriate correction or explanation is required.
- e. On page 12, lines 5-16, the content “new translation-example dictionary 402” appears to be “new translation-example dictionary 403”, because the same reference

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number is also referred to “commonly used dictionaries” on page 11, line 10 and “normal dictionary” in Fig. 9, and the same text label “new translation-example dictionary” is assigned to reference number 403 in Fig. 10. Appropriate correction is required.

f. In Fig. 10, the arrow of the line between S50 and 403 appears to point to 403 (not point to S50, also see Fig. 3). Appropriate correction is required.

4. Based on many errors found as stated above, applicant's cooperation is requested in correcting any errors and/or inconsistent terms of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “text data” (specification: page 7, lines 1-2 and Figs 4-5 and 13), does not reasonably provide enablement for “translation-example information”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

It is noted that, as broadest reasonable interpretation, the terms “translation-example information” can be interpreted as image or speech information that also may be “translated” with “dictionary^{ies}”, which is not disclosed in the specification, so that it cannot enable one

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skilled in the art to make and use the claimed invention, based on the disclosure. Even though the specification includes the terms “translation-example information”, the whole application is only focused on processing **text based** data, which has a different scope from the much broader scope of the terms “translation-example information”.

6. Claims 1-5 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The step (or component) of comparison with the translated text using normal dictionary is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is noted that the Fig. 9 shows step S36 (corresponding to the means for implementing the same functionality in apparatus claims) of “comparison with the translated text” using “normal dictionary 402”, which it is critical to understand and to make the claimed invention, otherwise, the claimed process (or structure) for creating a translation-example dictionary cannot be completed. Since this step (or component) is missing or unclear (see disclosure objection above), it cannot enable one skilled in the art to make and use the claimed invention, without undue effort.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-5, the limitation "comparing first translation-example information...detect if there is any differing **portion**" is vague, since the claimed limitation can be interpreted in many ways, such comparing any categories among text, speech, image, audio, and using any units of portion among letters, syllables, words, phrases, part-of-speech, sentences, paragraph, concepts, semantics, etc., which leads to the limitation being indefinite.

Conclusion

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Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolator, etc.) as follows:

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:00 p.m. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh
June 16, 2005

A handwritten signature in black ink, appearing to read "David D. Knepper".

DAVID D. KNEPPER
PRIMARY EXAMINER